

REMARKS

Applicants thank the Examiner for the thorough Examination of the application. No new matter is believed to be added to the application by this amendment.

Status of the Claims

Claims 1, 5-8 and 10-23 are pending in the application. Claims 5 and 6 have been amended to improve their language without reducing their scope. Claims 21-23 find support at page 17, lines 5-15 of the specification.

Claim Rejections Under 35 USC § 103(a)

Claims 1, 5-8, 10-13, 18 and 20 have been rejected under 35 USC § 103(a) as being obvious over Shinozuka et al. US '305 (US 5,298,305) in view of JP '789 (JP 09098789) further in view of Nonoyama et al. US '924 (US 5,646,924). Claims 14-17 and 19 have been rejected under 35 USC § 103(a) over the same three references, further in view of Miyauchi et al. US '021 (US 5,878,021). Reconsideration and withdrawal of each of these rejections under 35 USC § 103(a) is requested based upon the following considerations.

Incorporation of Earlier Remarks

The rejections in the instant office action are over the same prior art and over the same claims as set forth in previous Office Actions. Distinctions of the invention over the applied prior art have been set forth in the Replies filed July 18, 2003, February 5, 2003 and July 22, 2002. For brevity, these distinctions are not reproduced here but are hereby incorporated by reference.

Response to New Points of Argument

In the Amendment filed July 18, 2003, independent claim 1 was amended to recite: "wherein jitter after overwriting does not exceed 15%." This embodiment of the invention was neither disclosed nor suggested by the applied prior art.

At page 2, lines 16-20 of the Office Action, the Examiner asserts:

Regarding the newly added limitation to claim 1, 'wherein jitter after overwriting does not exceed 15,' is an **inherent** property. Because Shinozuka et al. in view of JP 090998789 further in view of Nonoyama et al. has an information recording medium with equivalent layers and materials as the claimed invention, the jitter value after overwriting, is an **inherent** property of the prior art. (Emphases added).

However, the Federal Circuit stated in In re Robertson:

[T]o establish inherency, extrinsic evidence must make clear that the missing descriptive matter was necessarily

present in the thing described in the reference, and would be so recognized by persons with ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a set of circumstances is not sufficient. In re Robertson, 49 USPQ2d 1949 (Fed. Cir. 1999).

Further, it has been held that the mere fact that a certain thing may result from a given set of circumstances is not sufficient, and occasional results are not inherent. MEHL/Biophile International v. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999).

Yet further, even if one assumes *arguendo* that the prior art suggests a technology where jitter after overwriting does not exceed 15%, the invention shows additional properties that are neither disclosed or suggested by the prior art.

The invention yields an information recording medium that shows excellent overwriting properties even when exposed to extreme conditions for an extended period of time. The working examples in the specification contain sulfide in the protective film and also contains a specific element such as Si, P, etc. (as set forth in claim 1) that results in the excellent overwriting property after storage for 500 hours at 80 °C and 90% RH. See claims 21-21. That is, the inventive recording medium shows results for jitter (after storage and overwriting) that is neither disclosed nor suggested by the applied prior art.

The invention therefore displays unexpected results over the applied prior art.

As a result, the applied prior art fails to allege *prima facie* obviousness over claim 1. Claims dependent upon claim 1 are patentable for at least the above reasons. Also, unexpected results fully rebut any *prima facie* obviousness that can be alleged.

Information Disclosure Statement

The Examiner is respectfully requested to consider the Information Disclosure Statement filed September 23, 2003, and to make the initialed PTO-1449 form of record in the next official action.

Foreign Priority

The Examiner is respectfully requested to acknowledge foreign priority in the next official action.

The Drawings

The Examiner is respectfully requested to indicate whether the drawing figures are acceptable in the next official action.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that Applicants' claimed invention is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

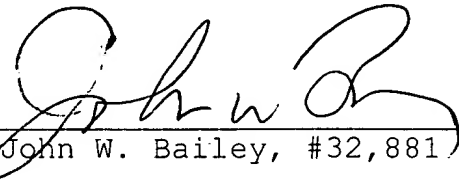
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Amendment dated February 10, 2004
Responsive to Office Action of October 10, 2003

Appl. No. 09/601,103

Respectfully submitted,

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